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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/384,456 02/02/95 PERSSON

EX 027500-386
EXAMINER

VD,N

ART UNIT PAPER NUMBER

22

2611

DATE MAILED:

05/16/95

RONALD L GRUDZIECKI
BURNS DOANE SWECKER AND MATHIS
PO BOX 1404
ALEXANDRIA VA 22313-1404

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 2 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-48 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☐ Claims _____ are rejected.

5. ☐ Claims _____ are objected to.

6. ☒ Claims 1-48 are subject to restriction or election requirement.

7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

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Part III DETAILED ACTION

1. This application is subjected to the transitional restriction provisions of Public Law 103-654 which becomes effective on June 8, 1995.

The transitional restriction provision permit applicant to have more than one independent and distinct invention examined in the same application by paying a fee for each invention in excess of one.

Since the transitional restriction provisions do not take effect until June 8, 1995, applicant should not file a response to this requirement before June 8, 1995, if Applicant desires to take advantage of those provisions.

If applicant does file a response prior to June 8, 1995 which purports to take advantage of the transitional restriction provisions, the response will be held to be informal/non-responsive under 37 CFR § 1.135(c).

If applicant files a response prior to June 8, 1995 because applicant wishes to waive applicant's rights to take advantage of the transitional restriction procedure which will become effective on June 8, 1995, the response must (1) include a statement electing a single invention in compliance with the restriction requirement, and (2) affirmatively state applicant's waiver of such rights. A response filed prior to June 8, 1995 electing a single invention which does not include a statement of

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waiver will be held to be informal/non-responsive under 37 CFR § 1.135(c).

If applicant responds on or after June 8, 1995, applicant must either: (1) elect the invention or inventions to be searched and examined and pay the fee set forth in 37 CFR § 1.17(s) for each independent and distinct invention in excess of one which applicant elects; or (2) file a petition under 37 CFR § 1.129(b) traversing the restriction requirement.

Proposed rules concerning the transition restriction were published in the Federal Register at 59 FR 63591 (December 12, 1995) and in the Official Gazette at 1170 OG 377 (January 3, 1995). The final rules are expected to be published on May 2, 1995. The final rules at 37 CFR § 1.17(s) will include the fee amount required to be paid for each additional invention as set forth in the preceding requirement for restriction.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-13, 16-22, drawn to a method of communication with a mobile station from a first base station and a second base station, classified in Class 455, subclass 33.2.

Group II. Claims 14-15, drawn to a circuitry of a mobile station in a cellular mobile radio telephone system, classified in Class 455, subclass 73.

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Group III. Claims 23-48, drawn to a method of directing signals between a first user of a radio communication system and a second user of a mobile station, classified in Class 455, subclass 54.1.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions of Group I, Group II and Group III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination (Group I) as claimed does not require the particulars of the subcombination (Groups II and III) as claimed because the combination does not require a particular circuitry of the mobile station, such as signal processing means, analog to digital conversion means, etc., (see Group II), and a step of forming a residue signal, etc., (see Group III), in order to perform the communication as set forth in the combination. The subcombination has separate utility such as they can be used to process any kind of communication signals, not necessary the handoff signal as set forth in the combination.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II and III, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nguyen Vo, whose telephone number is (703) 308-6728. The Examiner can normally be reached on Tuesday-Friday from 8:00 AM - 5:30 PM. The examiner can also be reached on alternate Monday.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Nguyen Vo *hVo*
May 11, 1995

Reinhard J. Eisenzopf
Reinhard J. Eisenzopf 5-14-95
Supervisory Patent Examiner
Group 260